

Applicants have elected, with traverse, Group II, Claims 5-17, drawn to a method of treating a brain disorder by administering a composition comprising a compound which inhibits the activation of a gene by NF- $\kappa$ B for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required. (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (M.P.E.P. § 803). Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing sufficient reasons or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The Examiner has categorized the relationships between Groups I and II as product and process of use. Patentable distinctness may be shown if either or both of the following can be shown: (1) that the process of using as claimed can be practiced with another materially different product or (2) that the product as claimed can be used in a materially different process (M.P.E.P. § 806.05(h)). The Examiner states that “[i]n the instant case the product can be used to inhibit gene activation in *in vitro* assays, which is a materially different process of using the product.”

However, the Examiner has not provided a sufficient analysis to support the materially different criteria required under § 806.05(h). Therefore, the Examiner’s reasoning is nearly a restatement of the Examiner’s conclusion that the two groups are patentably distinct. As the Examiner has provided insufficient reasons in support of her belief the Examiner has not met the burden placed upon her, and accordingly, the restriction is believed to be improper and should be withdrawn.

Application No. 10/677,301

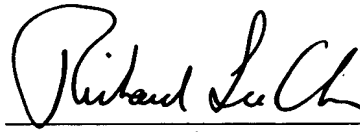
Reply to Restriction Requirement of August 25, 2004

Applicants submit this application is now in condition for examination on the merits  
and early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Norman F. Oblon

A handwritten signature in black ink, appearing to read "Richard L. Chinn", is written over a horizontal line.

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